

Remarks

Claims 7, 8, 12, 13, 15-19, 21, 28 and 29 are amended herein, and new claim 30 is added. Upon entry of this amendment, claims 1-30 will be pending. A check in payment of the fee for excess claims is submitted herewith. The Commissioner is authorized to charge any deficiencies in payment to Deposit Account No. 19-1345.

I. Response to Rejections under §112

In view of the following amendments and/or reasons, claims 7, 8, 12-17 and 19-29 are believed to satisfy 35 U.S.C. §112.

(a) Claim 7

Claim 7 has been amended to address the Examiner's confusion regarding the term "upstanding". The term "extending away from the base member" has been added to further clarify the spacial relationship of the substantially upstanding engagement portion. The term upstanding would readily be understood as meaning extending away from, so the amendment does not effect the scope of the claim.

(b) Claim 8

Claim 8 has been amended to replace the term "the upper end" with "an upper end" to overcome the Examiner's rejection for lack of antecedent basis. The editorial change has no effect on the scope of the claim.

(c) Claims 12 and 13

Claims 12 and 13 have been amended to change the spelling of "deformably" to "deformable". This spelling change has no effect on the scope of the claims. No amendments have been made regarding the term "upper end". Both claim 12 and 13 recite "an upper end", therefore the applicant submits that the 112 rejection based on this term lacking antecedent basis was improper and should be withdrawn.

(d) Claim 15

Claim 15 has been amended to change the term "engagement member" (for which the Examiner correctly noted lacked antecedent basis) to "engagement portion". This editorial change has no effect on the scope of the claim. The multiple dependency to claim 8 is deleted.

(e) Claim 16

Claim 16 has been amended to depend only from claim 13 and the term "the plate" has been changed to "the plate member" so that sufficient antecedent basis is provided in claim 13. This editorial change has no effect on the scope of the claim. The multiple dependency to claim 1 has been deleted.

(f) Claim 17

Claim 17 has been amended to change the term "the plate" to "the plate member" so that sufficient antecedent basis is provided in claim 13. This editorial change has no effect on the scope of the claim.

(g) Claim 19

Claim 19 has been amended to replace the term "the end" with "an end" to overcome the Examiner's rejection for lack of antecedent basis. This editorial change has no effect on the scope of the claim.

(h) Claim 21 and 29

Claims 21 and 29 have been amended to replace the term "substantially in the same plane" with "substantially coplanar" to overcome the Examiner's rejections for lack of antecedent basis. This editorial change has no effect on the scope of the claims.

(i) Claim 28

Claim 28 has been amended to replace the term "substantially the same length" with "substantially equal length" to overcome the Examiner's rejection for lack of antecedent basis. This editorial change has no effect on the scope of the claim.

II. Response to Rejections under 35 U.S.C. § 251

Claims 18-29 were rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter surrendered in the prosecution of the original application. Specifically, the Examiner objected to the removal of the term "integral" for describing the substantially rigid upper structure set forth in the claims.

Independent claims 18, 19, 28 and 29 have been amended to include the term "integral" so that each claim includes a "substantially rigid integral upper structure". Accordingly

claims 18, 19, 28 and 29, dependent claims 20-27 and new claim 30 are submitted as patentable under 35 U.S.C. 251.

Claims 18-29 were additionally rejected under 35 U.S.C. 251 as being based on a defective reissue declaration. Applicant submits with this Amendment an Application Data Sheet in compliance with 37 CFR 1.76 that acknowledges the filing of United Kingdom Application No. 9517993.3 from which priority is claimed in the subject application. Thus, in accordance with 37 CFR 1.63 and MPEP 1417, no new declaration is required in order to perfect Applicant's foreign priority claim.

III. Response to Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-29 as being unpatentable over Schuessler (U.S. Patent No. 5,160,209). In essence, the Examiner has restated the final rejection in the prosecution of the original application that was overcome by the claim amendments embodied in the issued claims presented as claims 1-17 in this reissue application. While authorized under the rules to reject the issued claims, the Examiner has done so in this case without citing any new art or presenting any additional arguments to support the reversal of the Patent Office's position as to the patentability of claims 1-17 in the original application.

(a) Claims 1-17

Claim 1 is directed to a ring binder having a prong bushing (securing means) having a construction which greatly facilitates the manufacture of the ring binder. The connection of the engagement portion (e.g., post) directly to the rigid upper portion eliminates connection eyelets. Moreover, the arrangement of the securing elements allows the securing means and upper structure to be assembled prior to the attachment of the ring binder to the base member (e.g., a notebook cover).

More particularly, claim 1 is directed to a ring binder adapted to be secured to a base member, the ring binder comprising:

- a substantially rigid integral upper structure;
- a pivotable lower structure supported by said upper structure;
- a plurality of ring members mounted to said lower structure; and
- at least one integral securing means for securing said ring binder to said base member, said at least one securing means including,

an engagement portion **in direct engagement with the upper structure** for attaching said securing fastener to said upper structure; and
a plurality of securing elements for securing said ring binder to the base member, **at least 75% of said elements extending away from a longitudinal axis of the engagement portion.**

Claim 1 is nonobvious and patentable over the prior art of record, including in particular Schuessler, U.S. Patent No. 5,160,209, in that none of the references show or suggest a ring binder having at least one integral securing means with an engagement portion **in direct engagement with the upper structure.**

Schuessler discloses a ring binder 10 having fasteners 16 and 18 for fastening the ring hardware 14 to a cover 12 of the binder. The fasteners 16 and 18 have an anchor plate 54 and post 56. The anchor plate 54 includes a series of attachment prongs 62 for securing the fastener to the binder. As shown in Fig. 6, the post 56 of each fastener 16, 18 is received in a corresponding sleeve or eyelet 52 in the ring support plate 44. The post 56 is not in direct engagement with the ring support plate 44 because the standoff sleeve 52 intervenes between the post and the support plate.

Schuessler fails to show or suggest a ring binder with an integral securing means having an engagement portion which is **in direct engagement with an integral upper structure**, as required by claim 1. The claimed ring binder advantageously requires fewer steps than the ring binder of Schuessler to secure the ring carrying structure to the cover. The claimed ring binder can be easily and simply attached to the cover by securing one end of the rivet 30 to the support plate 4 and the other end of the rivet to the cover 40. In contrast, the ring binder of Schuessler comprises a stand off sleeve or eyelet 52 for engaging the upper structure of the ring carrying structure that must be secured to the support plate in an additional step. Consequently, the claimed ring binder is a simpler design that is easier to secure to the binder cover. As a consequence of using the stand off sleeve or eyelet, the securing fastener of the ring binder in Schuessler requires a more intricate assembly process resulting in a securing fastener that is not in direct engagement with an integral upper structure for the purpose of attaching the fastener to the upper structure.

Moreover, claim 1 requires that at least 75% of the securing elements of the securing means extend away from a longitudinal axis of the engagement portion. As stated in the Office action, Schuessler does not disclose any such orientation of the securing elements.

Applicant submits that it would not have been obvious to one of ordinary skill in the art to modify the ring binder design of Schuessler so that at least 75% of the securing elements extend away from a longitudinal axis of the engagement portion.

The securing elements of the claimed invention, with at least 75% of the elements extending away from the longitudinal axis of the engagement portion, provide a stronger engagement force with the cover that allows a simplified production process allowing attachment of the entire ring binder assembly to the cover. As shown in Fig. 2 of Schuessler, only 10 of the 24 securing elements (about 42%) extend away from the longitudinal axis of the engagement member. The securing elements of Schuessler provide less engagement force with the cover necessitating an assembly process requiring attachment of the securing elements to the cover prior to the attachment of the securing elements to the upper structure. This requires a more complex manufacturing process.

Because the securing elements of the claimed invention have sufficient engagement force, the securing fastener can first be riveted to the upper structure of the ring binder and then the whole assembly can be attached to the cover. Therefore the orientation of the securing elements of the claimed invention simplifies the ring binder production process. The securing elements and upper structure can first be made and assembled and then sent to another location for mounting on the cover. Accordingly, applicant submits that it would not be obvious to one of ordinary skill in the art to modify the ring binder of Schuessler to arrive at the claimed design that allows a stronger connection to the cover resulting in a simplified production process.

For at least the foregoing reasons, Claim 1 is submitted as nonobvious and patentable over Schuessler and the other references of record. Claims 2-17, depending directly or indirectly from claim 1, are patentable for the same reasons as claim 1.

(b) Claim 18

Claim 18 is similar to claim 1, except that it refers to a "securing fastener" rather than "securing means." Claim 18 is submitted as nonobvious and patentable over the prior art of record, including in particular Schuessler, for the same reasons as presented above for claim 1. Specifically, none of the references show or suggest a ring binder having at least one integral securing fastener with an engagement portion **in direct engagement with the upper structure** and a plurality of securing elements, **75% of which extend away from the longitudinal axis of the engagement portion**.

(c) Claims 19-27

Claim 19 is similar to claim 18, but more specifically points out that it is securing elements having free ends located farther from the engagement portion that satisfy the requirement of 75% extending away from the longitudinal axis. More particularly, claim 19 is directed to a ring binder adapted to be secured to a base member, the ring binder comprising:

- a substantially rigid integral upper structure;
- a pivotable lower structure supported by said upper structure;
- a plurality of ring members mounted to said lower structure; and
- at least one integral securing fastener for securing said ring binder to said base

member, said at least one securing fastener including,

an engagement portion **in direct engagement with the upper structure** for attaching said securing fastener to said upper structure, and

securing elements for securing said ring binder to the base member, the securing elements each having a free end located at an end of the securing fastener farthest from the engagement portion, **at least 75% of said elements extending away from a longitudinal axis of the engagement portion.**

Claim 19 is submitted as nonobvious and patentable over the prior art of record, including in particular Schuessler, for the same reasons as presented above for claim 1.

Specifically, none of the references show or suggest a ring binder having at least one integral securing fastener with an engagement portion **in direct engagement with the upper structure** and a plurality of securing elements, **75% of which extend away from the longitudinal axis of the engagement portion.**

Claims 20-27, depending directly or indirectly from claim 19, are patentable for the same reasons as claim 19.

(d) Claim 28

Claim 28 is similar to claim 18 but more specifically points out that it is securing elements having the same length which satisfy the requirement of 75% extending away from the longitudinal axis. More particularly, claim 28 is directed to a ring binder adapted to be secured to a base member, the ring binder comprising:

- a substantially rigid integral upper structure;
- a pivotable lower structure supported by said upper structure;
- a plurality of ring members mounted to said lower structure; and

at least one integral securing fastener for securing said ring binder to said base member, said at least one securing fastener including;

an engagement portion **in direct engagement with the upper structure** for attaching said securing fastener to said upper structure, and

securing elements for securing said ring binder to the base member, the securing elements each having substantially equal length, **at least 75% of said elements extending away from a longitudinal axis of the engagement portion.**

Claim 28 is submitted as nonobvious and patentable over the prior art of record, including in particular Schuessler, for the same reasons as presented above for claim 1. Specifically, none of the references show or suggest a ring binder having at least one integral securing fastener with an engagement portion **in direct engagement with the upper structure** and a plurality of securing elements, **75% of which extend away from the longitudinal axis of the engagement portion.** Accordingly, claim 28 is submitted as non-obvious and patentable of the references of record.

(e) Claim 29

Claim 29 is similar to claim 18 but more specifically points out that it is securing elements having free ends which are coplanar that satisfies the requirement for 75% extending away from the longitudinal axis. More particularly, claim 29 is directed to a ring binder adapted to be secured to a base member, the ring binder comprising:

a substantially rigid integral upper structure;

a pivotable lower structure supported by said upper structure;

a plurality of ring members mounted to said lower structure; and

at least one integral securing fastener for securing said ring binder to said base member, said at least one securing fastener including,

an engagement portion **in direct engagement with the upper structure** for attaching said securing fastener to said upper structure, and

securing elements for securing said ring binder to the base member, the securing elements each having a free end located at an end of the securing fastener, the free ends of the securing elements being substantially coplanar, and **at least 75% of said elements extending away from a longitudinal axis of the engagement portion.**

Claim 29 is submitted as nonobvious and patentable over the prior art of record, including in particular Schuessler, for the same reasons as presented above for claim 1. Specifically, none of the references show or suggest a ring binder having at least one integral securing fastener with an engagement portion **in direct engagement with the upper structure** and a plurality of securing elements, **75% of which extend away from the longitudinal axis of the engagement portion**. Accordingly, claim 29 is submitted as non-obvious and patentable of the references of record.

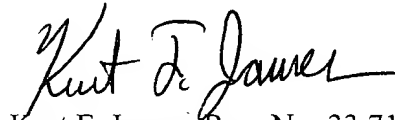
IV. New Claim 30

New claim 30 generally corresponds to claim 18 but further requires that the securing fastener be free from any intervening sleeve member between the fastener and the upper structure. Support for claim 30 may be found in the drawings (in particular Fig. 4) and column 2, lines 61-62. Accordingly, claim 30 is believed to be in form for allowance.

V. Conclusion

In view of the foregoing, reconsideration and allowance of claims 1-29 is requested. Consideration and allowance of new claim 30 is also requested.

Respectfully submitted,



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